

Atty Dkt. No.: 10011076-1  
USSN: 10/087,035

### **REMARKS**

In view of the above amendment and following remarks, the Examiner is requested to allow claims 1-11, 22, 27, 28, 31-37, 41-44 and 46-49, the only claims pending and under examination in this application.

#### ***Formal Matters***

Claim 45 has been canceled. Claims 46-49 have been amended to correctly depend from Claim 1 and for correct antecedent basis.

The remaining amendments to the claims are to make sure that, where appropriate, dependent claims terms have appropriate and clear antecedent basis, to correct typographical errors, and to correct errant dependencies.

As no new matter has been added by way of these amendments, entry thereof by the Examiner is respectfully requested.

#### ***Claim Objections***

Claims 47 and 48 are objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Examiner additionally states that should claim 1 be found allowable, claim 45 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

The Applicants have canceled Claim 45 and have amended Claims 47-48 to correctly depend from Claim 1. Withdrawal of the objections is respectfully requested.

#### ***Claim Rejections – 35 U.S.C. § 112***

Claims 46-48 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner states that Claim 46 recites "said checking" which lacks proper antecedent basis as there is no previous mention of "checking;" Claims 47-48 are also rejected due to their dependency from claim 46.

The Applicants have amended Claim 46 to remove the assertedly indefinite language. Since claims 46-48 have been amended to correctly depend from Claim 1,

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issues of dependency in those claims have been addressed. Withdrawal of the rejection is respectfully requested.

***Claim Rejections – 35 U.S.C. § 102***

Claims 1-22, 22, 27-28, 31-37, 41-46 and 48 are rejected under 35 U.S.C. § 102 as being anticipated by Zhou.

As noted by the Examiner, Zhou's actual filing date is after the filing date of the instant application. As such, the Examiner relies on the provisional applications to which Zhou claims priority in order to formulate this rejection. Without giving any particular details, on page 8, lines 3-4 of the Office Action, the Examiner indicates that provisional applications 60/265,103 and 60/301,298 are particularly relied up to formulate the rejection.

The Applicants have downloaded and reviewed 60/265,103 (enclosed as Exhibit A) and 60/301,298 (enclosed as Exhibit B) and have found no evidence of the subject matter relied upon by the Examiner to formulate this rejection.

Further, according to Zhou's applicant data sheet (enclosed as Exhibit C), both 60/265,103 and 60/301,298 were *abandoned* as of Zhou's filing date. Since there is no co-pendency between Zhou's patent application and 60/265,103 or 60/301,298, Zhou cannot actually claim priority to those provisional applications. Since Zhou cannot claim priority to 60/265,103 and 60/301,298, those earlier filed provisional applications cannot be relied upon to formulate this rejection.

Given that 60/265,103 and 60/301,298 – the two provisional applications that the Examiner specifically points towards as disclosing the subject matter of the rejected claims - are: a) not co-pendent with Zhou (and therefore cannot be part of Zhou's priority claim); and b) do not contain the subject matter relied upon by the Examiner to formulate this rejection, this rejection should be withdrawn.

The Applicants further note that the previously submitted Declaration of Robert Kincaid under 37 C.F.R. §1.131 provides a showing of facts that the inventor conceived of the claimed invention prior to the July 16, 2001. Given Zhou's incorrect priority claim, the Applicants submit that Robert Kincaid's activities pre-date Zhou's earliest priority date under § 102(e).

In view of the foregoing discussion, this rejection may be withdrawn.

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***Claim Rejections – 35 U.S.C. § 103***

Claims 47-47 are rejected under 35 U.S.C. § 103 as being unpatentable over Zhou in view of Rothberg. The Applicants respectfully traverse this rejection.

As argued above, Given Zhou's incorrect priority claim, the Applicants submit that Robert Kincaid's activities pre-date Zhou's earliest priority date under § 102(e).

Given the above, the Applicants submit that Zhou's disclosure cannot preclude the patentability of the instant claims, and this rejection may be withdrawn.

Withdrawal of this rejection is respectfully requested.

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**CONCLUSION**

In view of the amendments and remarks above, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance.

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Mike Beck at (408) 553-3864.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10020049-1.

Respectfully submitted,

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By: 

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